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EXAMINER

HYUN, PAUL SANG HWA

ART UNIT	PAPER NUMBER
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1743

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/043,681

Applicant(s)

MARKART, ERNST

Examiner

Paul S. Hyun

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 13-16 and 18-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 11, 13-16, 18-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

REMARKS

In response to the Office action dated 12/06/06, Applicant cancelled claims 12 and 17 and amended claims 11 and 13-16. Thus, claims 11, 13-16, 19 and 20 remain pending for prosecution.

The claim objection cited in the previous Office action has been withdrawn in light of the amendments.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims **13 and 14** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

The amended claim 13 contains claim language that is not supported by the originally filed Specification. Specifically, limitations that further limit the spring arm, such as "a surface for carrying an end portion of a test strip" and a structural feature that enables the test strip to "ride[s] on the spring arm" and "bend away from the support surface" could not be found in the Specification.

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Claims **15, 16, 19 and 20** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

The amended claim 15 contains claim language that is not supported by the originally filed Specification. Specifically, limitations that further limit the two-armed lever, such as “the actuator arm and the clamping arm being angularly offset”, “the clamping lever “positioned overlying the support surface” and the “operable” movement of the actuator arm recited at the end of the claim could not be found in the Specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim **11** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation “support surface...**defining** a projection extending outwardly from the support surface...” is indefinite. The word “defining” suggests that the support surface is the projection. Yet, the same limitation also recites that the projection extends outwardly from the support surface, which suggests that the support surface and the

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projection are separate elements. It is unclear whether support surface is the projection, or if the projection and the support surface are different entities.

Claims **15, 16, 19 and 20** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 recites a pivotal clamping lever and a two-armed lever. It is not clear from the claim language whether the two elements are different.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim **11** is rejected under 35 U.S.C. 102(b) as being anticipated by Hönes et al. (US 5,424,035).

Hönes et al. disclose a test strip analysis system including a test strip with a test field and an analysis apparatus 2 for measuring the test field of the test strip. The analysis apparatus comprises a test strip holder 3, wherein the test strip holder 3 has a positioning means in the form of a retaining lug 26 that engages the test strip in a definite position relative to a support surface. The support surface comprises a projection 20 and a measurement opening 23 in the middle. The apparatus 2 further comprises two holding means 39 situated on the edges of the support surface spaced apart from one another for holding the edges of the test strip adjacent the support

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surface (see Figs. 1 & 2). When the test strip is positioned in the analysis system, the test field of the test strip is supported by the projection 20 and it is vertically spaced apart from the support surface and the measurement opening 23 (see Figs. 2 and 3).

Claims **13 and 14** are rejected under 35 U.S.C. 102(b) as being anticipated by Gassenhuber (US 4,934,817).

Gassenhuber discloses a test strip holder 18 (see Fig. 3). The strip holder comprises an insertion end, an inner end, a spring arm 60/44 extending outwardly from a support surface 32 (see Fig. 2) and deflectable in a direction toward the support surface, and a counter-pressure surface 38 overlying the spring arm, the counter-pressure surface extending parallel to the spring arm. The spring arm further comprises a detent ball 82 for engaging a recess in the test strip. When the test strip is inserted into the holder, the test strip rides between the spring arm and the counter-pressure surface such that it bends away from the support surface and towards the counter-pressure surface (see Fig. 2).

Claims **15 and 16** are rejected under 35 U.S.C. 102(b) as being anticipated by Gassenhuber.

Gassenhuber discloses a test strip holder 18 (see Fig. 3). When viewed upside down, the strip holder comprises a support surface 38, a pivotal clamping lever comprising a clamping arm 60/44 and an actuator arm 62 angularly offset from one another by 180 degrees. The pivotal clamping lever overlies the support surface and is

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supported for pivotal movement about an axis 56 positioned between the clamping arm and the actuator arm. The clamping arm is biased towards the support surface and is capable of engaging with a surface of the test strip opposite the support surface. The actuator arm is capable of moving towards the support surface for insertion and removal of the test strip. The clamping arm further comprises a detent ball 82 for engaging a recess in the test strip the test strip.

Response to Arguments

Applicant's arguments with respect to claim 11 have been considered but are moot in view of the new ground of rejection. The amendment changed the scope of the claim and necessitated a different interpretation of the Hönes et al. reference. Nonetheless, Applicant's argument with respect to the reference will still be addressed because they are relevant.

Before addressing Applicant's arguments, it should be noted that the limitation "A test field system, including at least one test strip...relative to the support surface" recited in claim 11 does not positively recite the elements of the test field system. Rather, the claim does not positively recite the elements of the test field system until the subsequent section of the claim, beginning with "the test field system comprising..." Therefore, the limitations recited in the first section of the claim were interpreted to be non-limiting. Only the limitations following "the test field system comprising..." were interpreted to be further limiting the claimed system.

Applicant's argument that Hönes et al. do not disclose a support surface having a projection is not persuasive. The apparatus disclosed by Hönes et al. comprises a

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support surface (not numbered) spanning the entire width of the apparatus. The support surface comprises a projection 20 in the middle (see Fig. 2). It can be clearly seen from Figure 2 that projection 20 extends outwardly from the support surface by a distance equal to the thickness of the projection. When the test strip is positioned on top of projection 20, the test field of the test strip is spaced apart from measurement opening 23 by a distance equal to the thickness of projection 20 plus the thickness of the support surface.

Applicant's arguments with respect to claims 13-16, 19 and 20 have been considered but are moot in view of the new grounds of rejection. The amendments changed the scope of the claims and necessitated new grounds of rejections. Claims 13 and 14 are now rejected under 35 U.S.C. 102(b) as being anticipated by Gassenhuber (US 4,934,817). As for claims 15 and 16, they remain rejected under 35 U.S.C. 102(b) as being anticipated by Gassenhuber (US 4,934,817). However, the amendments necessitated a new interpretation of the reference.

It should be noted that like claim 11, independent claims 13 and 15 also contain claim language that do not positively recite the elements of the test field system. In claim 13, the limitation "A test strip system, including...relative to the support surface" does not positively recite the elements of the test strip system. In claim 15, "A test strip system including...relative to the support surface" does not positively recite the elements of the test strip system.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul S. Hyun whose telephone number is (571)-272-8559. The examiner can normally be reached on Monday-Friday 8AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PSH
3/8/07


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